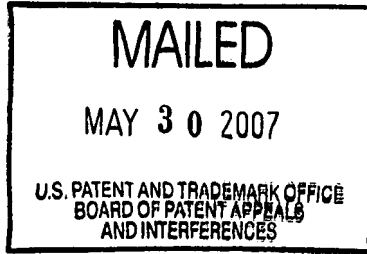


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRANKO KOVACEVIC  
and  
KEVORK KECHICHIAN

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Application 09/491,121

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on March 20, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

**APPEAL BRIEF**

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on October 13, 2005.

37 CFR § 41.37(c)(1) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

....

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

The Appeal Brief is missing the following sections:

1) “Summary of Claimed Subject Matter,” as set forth in 37 CFR § 41.37(c)(1)(v). The “Summary of claimed subject matter” appearing on pages 2-5 of the Appeal Brief filed October 13, 2005, is deficient because it does not map the claimed invention to the independent claims. Correction is required.

2) “Evidence appendix,” as set forth in 37 CFR § 41.37(c)(1)(ix); and

3) “Related proceedings appendix,” as set forth in 37 CFR § 41.37(c)(1)(x).

A Supplemental Appeal Brief in compliance with § 41.37(c) is required.

### **EXAMINER’S ANSWER**

An Examiner’s Answer was mailed on January 1, 2006. A review of the Examiner’s Answer reveals that it is not in compliance with §1207.02 of the Manual of Patent Examining Procedure (MPEP). Specifically, it is noted in the Examiner’s Answer that the section identified as Evidence Relied Upon states that “[n]o evidence is relied upon by the Examiner in the rejection of the claims under appeal” [page 2]. However, the claim rejections are listed on page 3 as follows:

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogenboom et al (5,517,250) in view of Ort (6,043,828); and

Claims 22-24 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hoogenboom et al (5,517,250).

Section 1207.02 of the Manual of Patent Examining Procedure

(MPEP) (8<sup>th</sup> Ed., Rev. 3, August 2005) states in part:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Correction is required.

**CONCLUSION**

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) hold the Appeal Brief filed October 13, 2005, defective, notify appellants to submit a Supplemental Appeal Brief which corrects the

“Summary of Claimed Subject Matter, ” the “Evidence Appendix” and the “Related Proceedings Appendix”;

2) for the Examiner to consider the Supplemental Appeal Brief. If the Supplemental Appeal Brief is in compliance with 37 CFR 41.37, the Examiner may acknowledge such consideration on Form PTOL-90;

3) issue and mail a PTOL-90 citing the references used to reject the claims on appeal (“Evidence Relied Upon”); and

4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Application 09/491,121

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